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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,940	11/27/2001	Marvin B. Bacaner	MBN 9045.9	1497

321 7590 01/30/2002

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

EXAMINER

HENLEY III, RAYMOND J

ART UNIT	PAPER NUMBER
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1614

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/765,675

Applicant(s)

DOUIN ET AL.

Examiner

Gina C. Yu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Receipt is acknowledged of Reply filed on November 16, 2001. Claims 1-83 are pending and remain rejected.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

(A) Claims 1-19, 21, 22, 30-62, and 68-83 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle et al. (EP 0842652 A1) in view of Ziegler et al. (U.S. Pat. No. 5,135,748).

The rejection is maintained for reasons of record as stated in the previous action.

(B) Claims 23-29 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle et al. and Ziegler et al. as applied to claims 1-19, 21, 22, 30-62, and 68-83 above, and further in view of Simonnet (EP 078114 A1).

The rejection is maintained for reasons of record as stated in the previous action.

(C) Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Restle et al., Ziegler et al., Simonnet as applied to claims 1-19, 21-63, and 68-83 above, and further in view of Matzik et al. (U.S. Pat. No. 5,716,418).

The rejection is maintained for reasons of record as stated in the previous action.

(D) Claims 64-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Restle et al., Ziegler et al., Simonnet, and Matzik et al., as applied to claims 1-63 and 68-83 above, and further in view of Decoster et al. (Abstract, JP 10338899A).

The rejection is maintained for reasons of record as stated in the previous action.

Response to Arguments

Applicant's arguments in respect to the claim rejections made under 35 U.S.C. § 103(a) have been fully considered but they are not persuasive.

I. Applicants assert that the previous rejection lacks prima facie case obviousness because there is no motivation to combine the references cited. Specifically, applicants argue there is no "clear and particular" showing of such motivation in the proposed combination of Restle in view of Ziegler. Applicants' allegation of the nonobviousness is based on the fact that Ziegler's invention requires an additional component beside the cationic polysaccharides of the instant claims. Examiner respectfully disagrees with applicants' position. Office Action in p. 3, lines 10-15 states that Ziegler does require the combination of both the cationic polysaccharides and quaternary ammonium functionalized phosphate esters in order to achieve the proposed enhancement of the moisture retention on skin. The proposed modification of Restle is done "as taught by Ziegler", wherein the reference is made to the statements in p. 3, lines 10-15. The rejection should not be interpreted to mean that a routineer would pick the cationic polysaccharide only and leave out the quaternary ammonium functionalized phosphate esters, when the Office Action indicated that the reference teaches both components are necessary to achieve the desired results.

II. Applicants further argue that there is no reason to add the cationic polymer of Ziegler in Restle because the benefits of the composition in Ziegler are different from or not disclosed in applicants' specification. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior

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art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). To establish a prima facie obviousness, examiner's proposed reason to combine the references do not have to coincide with the applicants' reason to come up with the instant invention, so long as the proposed motivation is found in the references and not from applicants' disclosure. In this case, the fact that applicants have not recognized the benefits of Ziegler's invention does not necessarily negate the obviousness of the combined teachings of Restle and Ziegler.

III. Applicants also argue that even combining Ziegler's entire combination with the Restle would not be obvious because Ziegler's composition is in the form of emulsion, as opposed to nanoemulsion. Applicants also state it would not be reasonable to combine components found in an emulsion with components of a nanoemulsion, asserting that such combination is improper. Examiner respectfully disagrees, as there are evidences that the cationic surfactants used in typical emulsions are also employed in both Restle's and applicants' nanoemulsions. See Dubief et al., US 6120757, col. 4, line 63 – col. 6, line 65; col. 6, lines 17 - 23 (teaching aqueous dispersion comprising organosiloxane and water-insoluble cationic surfactants). Thus applicant's argument that it would not be reasonable to combine components found in an emulsion with components of a nanoemulsion is not persuasive.

VI. In response to applicants' argument that examiner's rejection is an improper hindsight reconstruction based on applicants' specification with isolated and non-combinable sections of the references, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

V. Finally, applicants argue that the rejections made in reliance of additional references, Simonnet, Matzik, and Decoster, respectively, fail to cure the deficiencies of the primary rejection made over Restle and Ziegler. This argument is rendered moot, as the rejection made over Restle and Ziegler is maintained for the reasons explained above.

Conclusion

Examiner maintains the position that the claimed composition is an obviousness variation of Restle in view of Ziegler, Simonnet, Matzik, and Decoster. In absence of any evidence showing unexpected results of the combination of the prior arts, the rejections under 35 U.S.C. § 103 (a) are proper.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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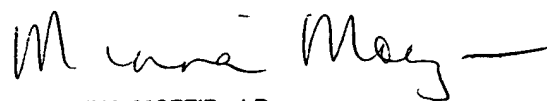
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezi can be reached on 703-308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
January 26, 2002



MINNA MOEZIE, J.D.
SUPERVISORY PATENT EXAMINER
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